

Serial No. 10/038,830

Page -2-

REMARKS

Claims 1-17 and 19-29 are pending. Favorable reconsideration of the application is requested in light of the following remarks.

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (EP 0339634) in combination with Lentini et al. (U.S. 5,665,368), Stoner et al. (U.S. 5,902,574), George et al. (U.S. 5,500,211), Cohen et al. (5,560,917), Berger (U.S. 5,008,293), Soler et al. (U.S. 6,113,926), Ha et al. (U.S. 5,997,887), Chekroun (EP 0554332 B1) and McAtee et al. (U.S. 5,811,111). The remaining claims are rejected as being unpatentable over a combination of two or more of the cited references. Applicant traverses the rejection on the following grounds: (1) The Examiner has used improper hindsight construction in combining the cited references; and (2) Even if the references are combined, they do not individually or in combination teach the claimed invention.

A. The Examiner Has Used Improper Hindsight Construction in Combining the Cited References.

Applicant respectfully maintains that the Examiner has used improper hindsight construction in combining the ten cited references listed above. Specifically, the examiner has used applicant's formulation as a template and selected elements from each of the references to fill the gaps. This type of construction is impermissible. In re Gorman, 933 F.2d 982, 987 (Fed. Cir. 1991) ("It is impermissible, however, simply to engage in hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. The references themselves Must provide some teaching whereby the applicant's combination would have been obvious.")

The Examiner states that the teaching or suggestion for combining the ten cited references arises from the fact that all of the references relate to "the application of compositions to the skin." Under this theory, any composition that can be applied to the skin is in the same field as the invention, e.g., cleansers, moisturizers, make-up (including eyeliner, eyeshadow, base, blush), face paint used at children's parties, tattoos, depilatories, acne medication, psoriasis medication, bleaches, pharmaceutical product such as Retin-A, etc. The "field," as defined by the Examiner, is so large that it includes art from clearly unrelated compositions. As such, the scope of the relevant art defined by the Examiner is too broad.

Serial No. 10/038,830

Page -3-

The Federal Circuit has defined the proper scope of the relevant prior art to include that which is "reasonably pertinent to the particular problem with which the inventor was involved." Stratoflex, Inc. v. Aeroquop Corp., 713 F.2d 1530, 1535, 218 U.S.P.Q. 871, 876 (Fed. Cir. 1983) (quoting In re Wood, 599 F.2d 1032, 1036, 202 U.S.P.Q. 171, 174 (C.C.P.A. 1979)); Also see, In re Gorman, 933 F. 2d 982, 986 (Fed. Cir. 1991). The particular problem faced by the Applicant of the present invention was the formulation of a shaving cream composition that could be used without applying water to the face. Given this particular problem, the relevant prior art would be references that a person of ordinary skill would reasonably have consulted and applied its teachings in seeking a solution to the problem that the inventor was attempting to solve. The references cited by the Examiner do not address the problem faced by the inventor and a person of ordinary skill would not have consulted these references to resolve the problem faced by the inventor.

1. McAtee

McAtee teaches a composition for treating acne and its attendant skin lesions, blemishes and other imperfections. McAtee does not address the problem of formulating a shaving cream composition that could be used without applying water to the face. Therefore, a person of ordinary skill would not look to McAtee for a solution to the waterless shaving problem.

Furthermore, McAtee discloses micronized Teflon as a cleaning agent for the delivery of a wide array of ingredients to treat skin conditions. In contrast, Applicant uses Teflon as a non-water based lubricant. A person of ordinary skill would not look to a reference that is using Teflon as a cleaning agent to find a non-water based lubricant for the inventive composition.

2. Berger

Berger teaches the use of chlorphenesin to reduce skin inflammation. Berger does not address the problem of formulating a shaving cream composition that could be used without applying water to the face. Therefore, a person of ordinary skill would not look to Berger for a solution to the waterless shaving problem.

Furthermore, Berger discloses the use of chlorphenesin as an anti-inflammatory agent in a skin treatment composition. In contrast, Applicant uses chlorphenesin as an anti-bacterial agent in a shaving composition. A person of ordinary

Serial No. 10/038,830

Page -4-

skill would not look to a reference that is using chlorphenesin as an anti-inflammatory agent to find an antibacterial agent for the inventive shaving cream composition.

3. Soler

Soler teaches the use of willow herb extracts and allantoin for the use in the cosmetic and pharmaceutical industries in topical formulations. Soler does not address the problem of formulating a shaving cream composition that could be used without applying water to the face. Therefore, a person of ordinary skill would not look to Soler for a solution to the waterless shaving problem.

Furthermore, Soler teaches the use of willow herb extracts and allantoin for hormonal or anti-hormonal therapy. In contrast, Applicant uses willow herb extracts and allantoin as soothers or anti-bleeding agents. A person of ordinary skill would not look to an anti-androgenic composition in order to find compounds to act as soothers or anti-bleeding agents in a shaving composition.

4. Ha

Ha teaches the use of PEG's, licorice extracts and sunblocks in a composition to cover skin imperfections. Ha does not address the problem of formulating a shaving cream composition that could be used without applying water to the face. Therefore, a person of ordinary skill would not look to Ha for a solution to the waterless shaving problem.

Furthermore, Ha teaches the use of PEG's, licorice extracts and sunblocks in a composition for camouflaging skin imperfections. In contrast, Applicant uses the ingredients as a soother and humectant. A person of ordinary skill would not look to a composition providing coverage for skin imperfections for a soother and humectant in a shaving cream composition.

5. Chekroun

Chekroun teaches the use of phenonip in a topical composition to improve the appearance of skin and hair. Chekroun does not address the problem of formulating a shaving cream composition that could be used without applying water to the face. Therefore, a person of ordinary skill would not look to Chekroun for a solution to the waterless shaving problem.

Serial No. 10/038,830

Page -5-

Furthermore, Chekroun teaches the use of phenonip as a cosmetic, improving the appearance of hair and skin. In contrast, Applicant uses phonip as an anti-bacterial agent. A person of ordinary skill would not look to a combination teaching the use of phenonip, in a cosmetic, for use as an anti-bacterial in a shaving composition.

6. Cohen

Cohen is a cosmetic makeup composition that teaches the use of panthenol and silicones in a pigmented composition that is effective against sun-induced skin damage. Cohen does not address the problem of formulating a shaving cream composition that could be used without applying water to the face. Therefore, a person of ordinary skill would not look to Cohen for a solution to the waterless shaving problem.

Furthermore, Cohen discloses the use of panthenol and silicones in a composition to protect the skin against sun damage. In contrast, Applicant uses panthenol and silicones in a shaving composition to soften the hair shaft. A person of ordinary skill would not look to a pigmented makeup composition to find agents that would facilitate shaving without water.

7. Lentini

Lentini teaches the use of sunscreen, sodium hyaluronate and phenonip in sprayable compositions to color skin, hair or to deliver an active agent. Lentini does not address the problem of formulating a shaving cream composition that could be used without applying water to the face. Therefore, a person of ordinary skill would not look to Lentini for a solution to the waterless shaving problem.

Improper hindsight was used in Lentini, Cohen, McAtee, Chekroun, Ha, Soler, Berger and Cohen because none of these references suggest combining the elements of the various references. Furthermore, the references do not address the problem faced by the inventor, and therefore, are not relevant prior art.

The Examiner did not consider the problems faced by Applicant when choosing these references, only the solution, namely, the composition itself. In doing so, the Examiner uses these references for no other reason than to fill the gaps of compounds contained in Applicant's composition which is clearly impermissible as hindsight reconstruction.

Serial No.10/038,830

Page -6-

B. Even If The References Are Combined, They Do Not Individually Or In Combination Teach the Claimed Invention.

Applicant maintains that the percentages addressed in the claims are critical to the usefulness of the product. These percentages, if not taught by the references, make them inapplicable to Applicant's composition because differing concentrations of these compounds have different applications which do not suit the Applicant.

The Examiner states that Smith (EPO 0339634) teaches a shave gel composition comprising water (40-90%), a salt of hyaluronic acid preferably sodium (.01-5.0%), allantoin (.01-1.0%), botanical plant extracts, post foaming agents, and additional additives like perfumes, skin conditioners, preservatives and humectants, and soap (4-35%). However, at a minimum, Smith does not show or suggest 0.25 to 5% silicone lubricant as recited in the claims, and thus Smith does not show or suggest the present invention. Furthermore, Smith does not address the problem of formulating a shaving cream composition that could be used without applying water to the face. In fact, the Smith formulation includes soap (4-35%) which would require water to wash off. Accordingly, there is no suggestion of combining Smith with any other references to arrive at the inventive composition.

Stoner does not make up for the deficiencies of Smith. Stoner teaches a complex two-step shaving treatment using two different compositions. In the first composition, Stoner suggests the use of humectants and silicones; however, no percentages are suggested, and the percentage of the ingredients is critical to the present invention. Stoner then requires the application of a second composition, an aftershave splash, lotion or gel which contains humectant. Col. 3, lines 26-44. The shaving method disclosed by Stoner is not a waterless shaving method but a traditional shaving method, namely, shaving cream is applied to the shaving area, the area is shaved and then rinsed. The shaved area is then contacted with an aftershave preparation, such as an aftershave splash or gel, which contains a humectant which penetrates the shaved hair, allowing it to rehydrate more quickly. Col. 3, lines 45-58. The composition of the present invention combines the functions of the aftershave and shaving cream. Thus, the hair is hydrated prior to the shaving, allowing a person to shave with little or no water. typical Stoner does not teach the use of PEG-8 dimethicone. The percentage ranges of the recited ingredients result in certain advantages of the composition that are not shown, taught, or suggested by Stoner. Thus Stoner, alone or in combination with Smith, does not render the present invention obvious.

Cohen has nothing to do with shaving gels -- it concerns a pigmented make-up composition. For this reason alone, there is no basis to combine it with the foregoing

Serial No.10/038,830

Page -7-

references. Moreover, Cohen doesn't show 70-95% water or 0.01 to 5% sodium hyaluronate. Nor does it show the use of panthenol in the range of .05 to .5%. Thus Cohen also does not make up for the deficiencies of the foregoing references.

Berger shows the use of chlorphenesin in topical applications for the treatment of skin diseases. However, the ranges of use far exceed the ranges recited in the present claims. The range taught in Berger is from 2 to 15% whereas the range recited in the present claims is .1 to .2%. In any event, the Examiner has not provided any support for the alleged motivation to combine the teachings of a reference in the field of skin disease treatment with Smith or Stoner which teach shaving compositions.

Soler also has nothing to do with shaving compositions. It merely shows the use of willow herb extracts in the range of .1 to 30% and the use of allantoin in the range of .05 to .2% in topical treatment formulations for a variety of disorders. It clearly does not make up for the deficiencies of the foregoing references. Moreover, the Examiner has provided no evidence of the alleged motivation to combine the teachings of a reference in the field of antiandrogens of plants with the Smith or Stoner which teach shaving compositions.

Ha is directed to a topical composition used to cover pores. It has nothing to do with shaving gels. Even its reference to PEG-8 is different as Ha shows the use of PEG-8 in the range of 5 to 15% and no range for the use of licorice extract. In contrast, the claims of the present composition recite .25 to 5% use of PEG-8 dimethicone. The claims of the present composition also recite specific ranges of licorice extract (.001 to .01%) which result in certain advantages of the claimed composition when combined with other recited ingredients of the claimed composition. Thus, Ha alone or in combination with the foregoing references does not show or suggest the present invention.

Chekroun (EP 0554322B1), relates to a topical skin treatment, not a shaving composition. At best it shows .13% phenonip in dermic creams and lotions. In contrast, the claims of the present composition recite the use of phenonip in the range of .5 to 1.0%. Furthermore, the Examiner has not provided any support for the alleged motivation of someone of ordinary skill in the field to combine a reference in the field of dermic creams with shaving compositions.

McAtee is directed to a composition for the topical delivery of actives -- it has nothing to do with shaving compositions. Equally so Lentini has nothing to do with the shaving composition of the present invention.

Serial No.10/038,830

Page -8-

Claims 12, 13, 17, and 19-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith (5,958,394) in combination with White, Smith (EP 0339634), and Rucker. These rejections are respectfully traversed. The cited references taken singly or in combination do not show or suggest the present invention as claimed.

None of the references cited by the Examiner show or suggest spreading or rubbing residual shaving composition on the shaved area. This is an entirely novel step in the shaving process. The Examiner argues that it would have been obvious to one of ordinary skill in the art to combine the teachings of the cited references to derive a method of shaving that includes the step of spreading residual shaving composition on the shaved surface. However, the Examiner does not provide any evidence to support the allegation that this step obvious to one of ordinary skill in the art. The Examiner is using improper hindsight reconstruction to derive a method of shaving from the cited references that includes rubbing residual shaving composition on the shaved area, a step not shown or suggested by any of the references.

CONCLUDING REMARKS

In view of the foregoing remarks, it is believed that all claims are in condition for allowance. Reconsideration of all rejections and a notice of allowance are respectfully requested. Should there be any questions regarding this application, the Examiner is invited to contact the undersigned attorney at the phone number listed below.

Respectfully submitted,

Dated: August 11, 2003

Kathy Mojibi
Kathy Mojibi
Reg. No. 41,409

JEFFER, MANGELS, BUTLER & MARMARO LLP
Seventh Floor
1900 Avenue of the Stars
Los Angeles, CA 90067
Tel: (310) 203-8080